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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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DUKE W. YEE CARSTENS, YEE & CAHOON, L.L.P. P.O. BOX 802334 DALLAS, TX 75380			FISCHER, ANDREW J	
			ART UNIT	PAPER NUMBER
			3627	

DATE MAILED: 11/06/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/578,751

Applicant(s)

SHRADER ET AL.

Examiner

Andrew J. Fischer

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 29 October 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-15 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-15 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____. |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____. | 6) <input type="checkbox"/> Other: _____. |

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DETAILED ACTION

Acknowledgments

1. The amendment filed October 29, 2003 (Paper No. 10) is acknowledged. Accordingly, claims 1-15 remain pending.

Claim Rejections - 35 USC § 101

2. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

3. Claims 15 is rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

- a. Claims 15 is rejected under 35 U.S.C. 101 because the claimed invention is not within the technological arts. The claim still does not recite structure which would place it with the technological arts. See *In re Toma*, 575 F.2d 872, 197 USPQ 852, (CCPA 1978). Because Applicants have claimed a “product” the Examiner finds that claim 15 is directed towards a product and *not* a process. Because Applicants’ have claimed a product with “instructions for” doing particular tasks, they have not actually claimed that the tasks are performed.

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Claim Rejections - 35 USC § 112

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

5. Claims 14 and 15 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

a. Claim 15 is does not produce a useful, concrete and tangible result. The scope is therefore unclear. See the §101 above.

b. In claim 14, an erroneous paragraph has been inserted. Appropriate correction is required.

Claim Rejections - 35 USC § 102

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States. . . .

7. Claims 15 is rejected under 35 U.S.C. 102(b) as being anticipated by 'StreetPrices.com' website printout of January 25, 1999 ("Streetprices 1/99"). Streetprices 1/99 discloses computer instructions for generating a set of product profiles (see *e.g.* 'Computers', 'Flowers' and "Toys"),

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each identifying a given site URL (inherent); a list of one or more included items to be queried (the product to be searched), a scan interval (inherent in the graphs) and a site template (inherent in the search engine which captures the name and price data); periodically retrieving data from the given site URL (inherent in the x axis of the graph) according to the scan interval; parsing the data retrieved to generate a data record (inherent since it discloses the price over time); storing the data records (inherent); and the product profiles includes one or more triggers (a threshold price which sends an email when a price drops below a particular level).

8. Claims 15 is alternatively rejected under 35 U.S.C. 102(b) based upon a public use or sale of the invention. In this case, evidence to support the public use is the StreetPrices.com website. See the additional cited StreetPrices.com printouts noted in the previous office action (Paper No. 9, Paragraph No. 20).

Claim Rejections - 35 USC § 103

9. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

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10. Claims 1-14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Streetprices 1/99. Claim 15 is rejected above. Applicants have admitted that claims 1-14 are not patentably distinct from claim 15. The Examiner relies on this admission.¹

11. Functional recitation(s) using the word “for” (*e.g.* “for generating a set of product profiles” as recited in claim 15) have been considered but are given little patentable weight² because they fail to add any structural limitations and are thereby regarded as intended use language. A recitation of the intended use of the claimed product must result in a structural difference between the claimed product and the prior art in order to patentably distinguish the claimed product from the prior art. If the prior art structure is capable of performing the intended use, then it reads on the claimed limitation. *In re Casey*, 370 F.2d 576, 152 USPQ 235 (CCPA 1967) (“The manner or method in which such machine is to be utilized is not germane to the issue of patentability of the machine itself.”); *In re Otto*, 136 USPQ 458, 459 (CCPA 1963). See also MPEP §§ 2114 and 2115. Unless expressly noted otherwise by the Examiner, the claim interpretation principles in this paragraph apply to all examined claims currently pending.

If Applicants desire the phrases to be given greater patentable weight, the Examiner suggests removing “instructions for” and reciting simply --generating--. While this would remove the functional recitations, this suggestion has addressed the §101 rejection above.

¹ See 37 C.F.R. §1.104(c)(3) which states in part: “the examiner may rely upon admissions by applicant . . . as to *any matter* affecting patentability [Emphasis added.]”

² See *e.g. In re Gulack*, 703 F.2d 1381, 217 USPQ 401, 404 (Fed. Cir. 1983)(stating that although all limitations must be considered, not all limitations are entitled to patentable weight.).

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12. The Examiner concludes that Applicants have decided not to be their own lexicographer by indicating and defining claim limitations to have meanings other than their ordinary and accustomed meanings. To support this position, the Examiner relies on the following factual findings. First and as noted in the previous Office Action,³ the Examiner has carefully reviewed the specification and prosecution history and can not locate any lexicographic definition(s). Second, the Examiner finds that not only have Applicants not pointed to definitional statements in their specification or prosecution history, Applicants have also not pointed to a term or terms in a claim with which to draw in those statements.⁴ Third, after receiving express notice in the previous Office Action⁵ of the Examiner's position that lexicography is *not* invoked, Applicants have not pointed out the "supposed errors" in the Examiner's position regarding lexicography invocation in accordance with 37 C.F.R. §1.111(b) (*i.e.* Applicants have not argued lexicography *is* invoked). Finally and to be sure of Applicants' intent, the Examiner also notes that Applicants

³ See the Examiner's previous Office Action mailed July 29, 2003, Paper No. 9, Paragraph No. 17.

⁴ "In order to overcome this heavy presumption in favor of the ordinary meaning of claim language, it is clear that a party wishing to use statements in the written description to confine or otherwise affect a patent's scope must, *at the very least*, point to a term or terms in the claim with which to draw in those statements. [Emphasis added.]" *Johnson Worldwide Assocs. v. Zebco Corp.*, 175 F.3d 985, 989, 50 USPQ2d 1607, 1610 (Fed. Cir. 1999).

⁵ See again the Examiner's previous Office Action, Paper No. 9, Paragraph No. 17.

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have declined the Examiner's express invitation⁶ to be their own lexicographer.⁷ Accordingly and for due process purposes, the Examiner gives notice that for the remainder of the examination process (and unless expressly noted otherwise by the Examiner), the heavy presumption in favor of the ordinary and accustomed meaning is not overcome; the claims therefore continue to be interpreted with their "broadest reasonable interpretation" *In re Morris*, 127 F.3d 1048, 1054, 44 USPQ2d 1023, 1027 (Fed. Cir. 1997).⁸ The Examiner now relies heavily and extensively on this interpretation.⁹ Unless expressly noted otherwise by the Examiner, the preceding claim interpretation principles in this paragraph apply to all examined claims currently pending.

⁶ *Id.*

⁷ The Examiner's requirements on this matter were reasonable on at least two separate and independent grounds. First, the Examiner's requirements were simply an express request for clarification of how Applicants intend their claims to be interpreted so that lexicography (or even an *attempt* at lexicography) by Applicants was not inadvertently overlooked by the Examiner. Second, the requirements were reasonable in view of the USPTO's goals of compact prosecution, productivity with particular emphasis on reductions in both pendency and cycle time, and other goals as outlined in the USPTO's The 21st Century Strategic Plan, February 3, 2003 available at www.uspto.gov/web/offices/com/strat21/index.htm (last accessed November 5, 2003).

⁸ See also *In re Bass*, 314 F.3d 575, 577, 65 USPQ2d 1156, 1158 (Fed. Cir. 2002) ("In examining a patent claim, the PTO must apply the broadest reasonable meaning to the claim language, taking into account any definitions presented in the specification. Words in a claim are to be given their ordinary and accustomed meaning unless the inventor chose to be his own lexicographer in the specification.")(citations omitted); *In re Etter*, 756 F.2d 852, 858, 225 USPQ 1, 5 (Fed. Cir. 1985) (en banc); and MPEP §§ 2111 and 2111.01.

⁹ See 37 C.F.R. §1.104(c)(3) which states in part: "the examiner may rely upon admissions by applicant . . . as to *any matter* affecting patentability [Emphasis added.]"

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13. To the extent that the Examiner's interpretations are in dispute with Applicants' interpretations, the Examiner hereby adopts the following definitions—under the broadest reasonable interpretation standard—in all his claim interpretations.¹⁰ Moreover, while the following list is provided in accordance with *In re Morris*, the definitions are a guide to claim terminology since claim terms must be interpreted in context of the surrounding claim language.¹¹ Finally, the following list is not intended to be exhaustive in any way:

a. **Server:** “2. On the Internet or other network, a computer or program that responds to commands from a client.” Computer Dictionary, 3rd Edition, Microsoft Press, Redmond, WA, 1997.¹² **Client:** “3. On a local area network or Internet, a computer that accesses shared network resources provided by another computer (called a *server*).” *Id.* **Computer:** “Any

¹⁰ While most definitions are cited because these terms are found in the claims, the Examiner may have provided additional definition(s) to help interpret words, phrases, or concepts found in the definitions themselves or in the prior art.

¹¹ See *e.g. Brookhill-Wilk 1 LLC v. Intuitive Surgical Inc.*, 334 F.3d 1294, 1300, 67 USPQ2d 1132, 1137 (Fed. Cir. 2003) (abstract dictionary definitions are not alone determinative; “resort must always be made to the surrounding text of the claims in question”).

¹² Based upon Applicants' disclosure, the art of record, and the knowledge of one of ordinary skill in this art as determined by the factors discussed in MPEP §2141.03 (where practical), the Examiner's again finds that the *Microsoft Press Computer Dictionary* is an appropriate technical dictionary known to be used by one of ordinary skill in this art. See *e.g. Altiris Inc. v. Symantec Corp.*, 318 F.3d 1363, 1373, 65 USPQ2d 1865, 1872 (Fed. Cir. 2003) where the Federal Circuit used *Microsoft Press Computer Dictionary* (3d ed.) as “a technical dictionary” used to define the term “flag.” See also *In re Barr*, 444 F.2d 588, 170 USPQ 330 (CCPA 1971)(noting that its appropriate to use technical dictionaries in order to ascertain the meaning of a term of art) and MPEP §2173.05(a) titled “New Terminology”.

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machine that does three things: accepts structured input, processes it according to prescribed rules, and produces the results as output.” *Id.*

b. **Data** “Plural of the Latin *datum*, meaning an item of information. In practice, data is often used for the singular as well as plural the form of the noun.” *Id.*

c. **Web site** “A group of related HTML documents and associated files, scripts, and databases that is served up by an HTTP server on the World Wide Web. The HTML documents in a Web site generally cover one or more related topics and are interconnected through hyperlinks. Most Web sites have a home page as their starting point, which frequently functions as a table of contents for the site. Many large organizations, such as corporations, will have one or more HTTP servers dedicated to a single Web site. However, an HTTP server can also serve several small Web sites, such as those owned by individuals. Users need a Web browser and an Internet connection to access a Web site.” *Id.* **HTTP Sever** “1. Server software that uses HTTP to serve up HTML documents and any associated files and scripts when requested by a client, such as a Web browser. The connection between client and server is usually broken after the requested document or file has been served. HTTP servers are used on Web and Intranet sites. *Also called* Web Sever 2. Any machine on which an HTTP server program is running.” *Id.*

d. **Tag** “1. In programing, one or more characters containing information about a file, record type, or other structure. 2. In certain types of data files, a key or an address that identifies a record and its storage location in another file . . . 3. In markup languages such as SGML and

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HTML, a code that identifies an element in a document, such as heading or a paragraph, for the purposes of formatting, indexing, and linking information in the document.” *Id.*

14. Although Applicants use “instructions for” in the claims (*e.g.* claim 15), it is the Examiner’s position that the “instructions for” phrase(s) do not invoke 35 U.S.C. 112 6th paragraph because they do not recite “means for” and therefore fail prong one. See MPEP §2181 and the *Supplemental Examination Guidelines for Determining the Applicability of 35 USC 112 6th*.¹³

However, if Applicants desire to invoke 35 U.S.C. 112 6th paragraph, the Examiner respectfully requests Applicants to change the “instructions for” phrases to “means for” phrases and expressly state their desire on the record. Upon recitation of “means for” in the claims and upon receiving such express invocation of 35 U.S.C. 112 6th paragraph, the “means for” phrase(s) will be interpreted as set forth in the *Guidelines*.

Applicants are reminded that failure by Applicants to also address the 35 U.S.C. 112 6th paragraph issues in accordance with 37 C.F.R. §1.111(b) or to be non-responsive to this issue entirely will be considered a desire by Applicants NOT to invoke 35 U.S.C. 112 6th paragraph. Unless expressly noted otherwise by the Examiner, the preceding discussion on 35 U.S.C. 112 6th paragraph applies to all examined claims currently pending.

¹³ Federal Register Vol 65, No 120, June 21, 2000.

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Response to Arguments

15. Applicants' arguments filed October 29, 2003 (part of Paper No. 10) have been fully considered but they are not persuasive.

16. Regarding the §101 rejections, Applicants argue "that claim 15 recites a computer program product on a computer readable medium"¹⁴ The Examiner has reviewed claim 15 and can not locate "on a computer readable medium." "It is the *claims* that measure the invention. [Emphasis in original.]" *Johnson & Johnston Associates Inc. v. R.E. Service Co.*, 285 F.3d 1046, 1052, 62 USPQ2d 1225, 1228 (Fed. Cir. 2002) (en banc) (citations omitted). Until Applicants' claims actually recite a medium, they will not be construed to contain one. As Judge Clevenger has so eloquently summarized these types of arguments, "The invention disclosed in [Applicant's] written description may be outstanding in its field, but the name of the game is the claim." *In re Hiniker Co.*, 150 F.3d 1362, 1369, 47 USPQ2d 1523, 1529 (Fed. Cir. 1998).

17. Applicants next traverse the anticipation rejection for claim 15 and state:

Streetprices apparently uses 'robots' to crawl e-commerce website, uses categorization algorithms to improve results, and offers e-mail price alerts to customers when a price drops below a threshold.

In contradistinction, the present invention provides a computer program product at a client computer for collecting product data.¹⁵

18. While Applicants arguments are . . . quite novel, they are not persuasive.

¹⁴ Applicants' "Remarks" following Amendment 'B' in Paper No. 10, Page 5, last paragraph.

¹⁵ *Id.* at Page 7, ~ lines 5-9.

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19. Applicants next argue that Streetprices 1/99 does not parse the data retrieved. The Examiner again disagrees. One of ordinary skill in the art clearly recognizes that without parsing the data, the data collected at the web sites would be blob of mostly extraneous information.

20. Applicants argue that “[t]here is no suggestion, explicit or implicit, that the Streetprices Web site uses a site template to parse data retrieved from a given site URL.”¹⁶ Again, the examiner disagrees. The tags themselves within an HTML document provide a template. Moreover, the formatting of dollar values used by Steetprices is also a template. The use of product names and prices is another template.

21. Applicants also argue that:

The Office Action misapplies the concept of ‘inherent’ anticipation. An invention is said to be ‘anticipated’ when it is squarely described or described in a single reference as identified from one of the categories of 35 U.S.C. §102, commonly referred to as ‘prior art.’ . . . In some cases, however, when the claimed invention is not described in haec verba, the ‘doctrine of inherency’ is replied on to establish anticipation. Under the principles of inherency, a claim is anticipated if a structure in the prior necessarily functions in accordance with the limitations of a process or method claim. *In re King* [].¹⁷

22. The Examiner disagrees. In light of Applicants’ “robots” argument noted above, it should not be too surprising that Applicants have also misapplied inherency. The Examiner will point out some of the errors in Applicants’ response and provide a brief review of inherency.

¹⁶ *Id.* at Page 7, ~ lines 28-29.

¹⁷ *Id.* at Pages 7-8,

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23. First, the Examiner is unaware of the “squarely described” standard noted above. The Examiner respectfully traverses Applicants’ statement of law and requests Applicants to provide proper authority (*e.g.* MPEP cite) for the “squarely described” standard. Incidentally, although Applicants eventually cite *King*, they have not provided a pinpoint cite. And although the Examiner has again reviewed *King*, discussion of what is “squarely described” is not found.

24. Second, although “a claim is anticipated if a structure in the prior necessarily functions in accordance with the limitations of a process or method claim” is useful for *process* claims, claim 15 is not a process claim. Applicants have admitted that claim 15 is a *product* claim.¹⁸ Because the only independent claim in *King* was a process claim, *King* is clearly not on point.

25. Third, multiple references can be used in a §102 rejection. See MPEP §2131.01.

26. Applicants next go on to cite a bunch of interparty litigation cases on page 8 of their Remarks including *Continental Can Co. v. Monsanto Co.*, 948 F.2d 1264, 20 USPQ2d 1746 (Fed. Cir. 1991), and conclude with the statement that “Otherwise, the invention is not inherently anticipated.”¹⁹ The Examiner again notes while the cited phrases may be true on their face, the “Otherwise, the invention is not inherently anticipated” phrase is simply incorrect. The Examiner again respectfully requests Applicants to provide an authority for their conclusion. Because of

¹⁸ *Id.* at Pages 5, beginning of the last full paragraph, “Applicant submits that claim 15 recites a computer program product”

¹⁹ *Id.* at Page 8, ~ line 17.

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Applicants numerous legal errors misconstruing inherency, the Examiner will next provide a brief review of what is inherency.

Inherency

Generally

27. Merriam-Webster's Collegiate Dictionary defines "inherent" to mean "involved in the constitution or essential character of something" ²⁰ While the inherency doctrine had a markedly less than auspicious start, ²¹ it has become an integral part of our patent system today. As will be discussed, inherency as used in patent law today may or may not be as inclusive as in the so called "inherency doctrine" noted in *Seaborg*. In other words, while all discussion of the initial "inherency doctrine" includes inherency as defined today, not all discussions of inherency as defined today are applicable within the initial "inherency doctrine." The Examiner therefore notes and cautions that the initial "inherency doctrine" and inherency as used by patent practitioners today is different.

28. Although the original "inherency doctrine" did not contemplate non-prior art uses of inherency, it is now well established that inherency is not limited to the context of prior art. See *e.g. In re Reynolds*, 443 F.2d 384, 170 USPQ 94 (CCPA 1971) where inherency was applied to

²⁰ Merriam-Webster's Collegiate Dictionary, 10th Edition, Merriam-Webster Inc., Springfield, M.A., 1997.

²¹ *In re Seaborg*, 328 F.2d 996, 140 USPQ 662 (CCPA 1964) (declining to use the "inherency doctrine" and reversed the Board in a claim that read "1. Element 95.")

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35 U.S.C. §112 1st paragraph. In addition to the “inherency doctrine,” commentators, judges, and Applicants have also discussed “inherent anticipation”²² and other inherency topics.²³

Because however Applicants arguments are limited to inherency within the context of prior art, the Examiner will accordingly further limit his discussion to inherency within the context of prior art.

29. It is also important to keep in mind that inherency need not even be recognized by a person of ordinary skill in the art. “Inherency is not necessarily coterminous with the knowledge of those of ordinary skill in the art. Artisans of ordinary skill may not recognize the inherent characteristics or functioning of the prior art.” *Mehl/Biophile Int'l Corp. v. Milgraum*, 192 F.3d 1362, 1365, 52 USPQ2d 1303, 1305-06 (Fed. Cir. 1999); *Atlas Powder Co. v. Ireco Inc.*, 190 F.3d 1342, 1347, 51 USPQ2d 1943, 1946-47 (Fed. Cir. 1999). This inherency (and its relation to one of ordinary skill in the art) also applies to an unappreciated property or discovery. See *EMI Group North America, Inc. v. Cypress Semiconductor Corp.*, 268 F.3d 1342, 60 USPQ2d 1423, 1428 (Fed. Cir. 2001) (“The discovery of a previously unappreciated property of a prior art composition, or of a scientific explanation for the prior art's functioning, does not render the old composition patentably new to the discoverer.”). “In sum, [the Federal Circuit’s] precedent does not require a skilled artisan to recognize the inherent characteristic in the prior art that anticipates

²² See *Inherent Anticipation* by Steven C. Carlson, 40 IDEA 297 (2000).

²³ See *Inherency in Patent Law* by Irving N. Feit and Christina L. Warrick, 85 JPTOS 5, (January 2003).

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the claimed invention.” *Schering Corp. v. Geneva Pharmaceuticals, Inc.*, 339 F.3d 1373, 1378, 67 USPQ2d 1664, 1668 (Fed. Cir. 2003).

Summary: The Standard for Inherency During Ex Parte Examination

30. The Examiner cites three reasons why inherency need only be established by a preponderance of the evidence during ex parte examination. First, the USPTO must base all factual determinations on a preponderance of the evidence. Additionally, anticipation and inherency are a questions of fact. Therefore inherency during ex parte examination must also be determined by a preponderance of the evidence. Second, the presumption of validity under 35 U.S.C. §282 distinguishes issued patents from patent applications requiring inherency in infringement litigation to be established by clear and convincing proof while requiring inherency in ex parte examination to be established by only a preponderance of the evidence. And finally, the Examiner’s position is consistent with both the Administrative Procedure Act (APA) and the USPTO policy.

What’s Not In Dispute

31. Before this analysis begins, its important to note that in order to anticipate, all features of a claim must be shown either directly or inherently. In other words, “[t]o anticipate a claim, a prior art reference must disclose every limitation of the claimed invention, either explicitly or inherently.” *In re Schreiber*, 128 F.3d 1473, 1477, 44 USPQ2d 1429, 1431 (Fed. Cir. 1997). The

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Examiner agrees with this statement and adds that the these requirements for anticipation are statutorily mandated by 35 U.S.C. §102.²⁴

32. The Examiner also agrees that the *test* for inherency is whether or not the missing element(s) are present in the reference. *Continental Can*, 948 F.2d at 1268, 20 USPQ2d at 1749. Moreover, inherency may supply a single missing element or characteristic, or even the entire claimed invention. The extent of the inherent disclosure does not limit its anticipatory effect. *Schering*, 339 F.3d at 1379, 67 USPQ2d at 1669 (“Because inherency places subject matter in the public domain as well as an express disclosure, the inherent disclosure of the entire claimed subject matter anticipates as well as inherent disclosure of a single feature of the claimed subject matter. The extent of the inherent disclosure does not limit its anticipatory effect.”).

33. Finally, it apparently is not disputed that inherency may also apply to reference(s) during obviousness determinations as well. See MPEP §2112 citing *In re Grasselli*, 713 F.2d 731, 739, 218 USPQ 769, 775 (Fed. Cir. 1983) which expressly authorizes inherency in obviousness (35 U.S.C. §103) rejections.

Questions of Fact

34. First and as noted in *In re Oetiker*, 977 F.2d 1443, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992), “patentability is determined by preponderance of the evidence.” Also as noted in *Oetiker*,

²⁴ Although not necessarily pertinent to this discussion, it is self evident that requirements for utility are mandated by 35 U.S.C. §101 while requirements for obviousness are mandated by 35 U.S.C. §103.

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“factual determinations by the PTO must be based on a preponderance of the evidence”

Oetiker, 977 F.2d at 1449, 24 USPQ2d at 1447 (Plager, J. concurring). Finally, while it is well established that anticipation is a question of fact²⁵, it is also well established that inherency for anticipation purposes is also a question of fact.²⁶ The Examiner concludes that for this reason alone, inherency during ex parte examination need only be established by a preponderance of the evidence.²⁷

2) Presumption of Validity under 35 U.S.C. §282 Doesn't Apply

35. Applicants next generally cite *Verdegaal Bros., Inc. v. Union Oil Co.*, 814 F.2d 628, 2 USPQ2d 1051 (Fed. Cir. 1987); *Continental Can*; and *Constant v. Advanced Micro-Devices, Inc.*, 848 F.2d 1560, 7 USPQ2d 1057 (Fed. Cir. 1988) for various statements of law. While these statement may be true on their face, the use of these phrase confuses the *test* with the *standard* by which the test must be judged. While the Examiner agrees that the test for anticipation is that all claimed features are present, *Schreiber*, 128 F.3d at 1477, 44 USPQ2d at 1431, the cases cited by

²⁵ See e.g. *In re Hyatt*, 211 F3d 1367, 54 USPQ2d 1664, 1667 (Fed. Cir. 2000); *Bischoff v. Wethered*, 76 U.S. (9 Wall.) 812, 814-15 (1869).

²⁶ *Schreiber*, 128 F.3d at 1477, 44 USPQ2d at 1431 (noting that whether a claim limitation is inherent in a prior art reference for purposes of anticipation is a question of fact);

²⁷ See e.g. *Chester v. Miller*, 906 F.2d 1574, 15 USPQ2d 1333, 1337 (Fed. Cir. 1990) where the Federal Circuit also noted that Board was not precluded “from finding that anticipation has been established by a preponderance of the evidence.”

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Applicants (including *Continental Can*) say nothing regarding the *standard* by which this test must be judged.

Inherency During Ex Parte Examination: Standard of Proof

36. First, it is the Examiner's position that as a matter of law, the standard for establishing anticipation (and thus inherent anticipation) during ex parte examination is *lower than* the standard for establishing anticipation and inherency during an interparty patent infringement suit. Because of this lower standard, the Examiner need only prove that each element of the claimed invention is present in the reference (either directly or inherently) by a preponderance of the evidence.

37. In *In re Caveney*, 761 F.2d 671, 226 USPQ 1 (Fed. Cir. 1985), the Federal Circuit upheld an examiner's rejection under 35 U.S.C. §102(b) because the appellants offered to sell the claimed invention more than one year before filing. The court having considered the PTO's standard of proof required to set forth a prima facie case concluded that "preponderance of the evidence is the standard that must be met by the PTO in making rejections" *Caveney*, 761 F.2d at 674, 226 USPQ at 3. The court in *Caveney* noted that although there was conflicting evidence of the offer for sale and the PTO had not established its case by clear and convincing evidence, the court nevertheless concluded that the PTO met its burden. "Although the above-related activities may not be clear and convincing evidence of facts that show the claimed invention was offered for sale,

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we are satisfied that they establish such facts by a preponderance of the evidence.” *Caveney*, 761 F.2d at 675, 226 USPQ at 3.

38. The reasoning behind this result is quite simple. Issued patents have a presumption of validity acquired under 35 U.S.C. §282. Thus, invalidity of issued patents under *any* statutory provision requires proving such facts by clear and convincing evidence.²⁸ Ex parte examination, on the other hand, has no presumption of validity, see *In re Etter*, 756 F.2d 852, 225 USPQ 1, 3-6 (Fed. Cir. 1985)(en banc), allowing the USPTO to establish such facts by only a preponderance of the evidence. Because of these differing standards, the Examiner concludes that anticipation is *easier* to establish during ex parte examination than it is to establish during infringement. The court in *Caveney* having properly recognized this distinction noted:

From *In re Etter*, 756, F.2d 852, 225 USPQ 1 (Fed. Cir. 1985) (en banc), it is apparent that, due to 35 U.S.C. §282, the standard of proof required to properly reject the claims of a patent application is necessarily lower than that required to invalidate patent claims. *Caveney*, 761 F.2d at 674, 226 USPQ at 3.

²⁸ For other examples requiring clear and convincing proof after issuance, see: regarding anticipation, *Crown Operations Int'l, Ltd. v. Solutia Inc.*, 289 F.3d 1367, 1377-78, 62 USPQ2d 1917, 1923 (Fed. Cir. 2002) (where defendant *Crown* failed to invalidate the patent because they failed to show inherency by clear and convincing evidence); regarding 35 U.S.C. 112 1st paragraph and enablement, see *Morton Int'l, Inc. v. Cardinal Chem. Co.*, 5 F.3d 1464, 28 USPQ2d 1190, 1194 (Fed. Cir. 1993)(“At trial, [the defendant] had the burden of proving by clear and convincing evidence facts establishing lack of enablement”); regarding 35 U.S.C. 112 1st paragraph and written description, see *Amgen Inc. v. Hoechst Marion Roussel, Inc.*, 65 USPQ2d 1385, 1397 (Fed. Cir. 2003) (where the Federal Circuit upheld the district court’s “finding that [the defendant] had proven its case only by a preponderance of the evidence—not the clear and convincing standard required as a matter of law.”); and regarding omission of inventor, see *Environ Prods. v. Furon Co.*, 215 F.3d 1261, 1265, 55 USPQ2d 1038, 1042 (Fed. Cir. 2000)(noting that a party challenging patent validity for omission of an inventor must present clear and convincing evidence that the omitted individual actually invented the claimed invention).

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39. While *Caveney* applied to §102 and the on sale bar, the reasoning from *Caveney* applies equally to anticipation and, for that matter, *any* statutorily mandated requirement (*i.e.* 35 U.S.C. §§ 101, 103, 112, etc.). This reasoning behind applying *Caveney* to all statutorily mandated requirement is because such requirements are the only requirements which receive the presumption of validity upon issuance. Therefore, the standard the USPTO must meet to set forth a prima facie case *before* such presumption applies is only a preponderance of the evidence.

40. Having established that preponderance of the evidence is the standard in which the USPTO must meet to set forth a prima facie case of anticipation, it is a truism that all elements of anticipation must also be established by only a preponderance of the evidence. That is to say, each and every claimed element must be shown to exist either directly or inherently by only a preponderance of the evidence.²⁹

While this concept is easy to conceptualize for claim limitations directly disclosed in the prior art since the text and diagrams in the reference are usually enough evidence to show that the particular element is anticipated by a preponderance of the evidence, inherent limitations are not as straight forward. Because of the standard, the test for inherency during ex parte examination therefore becomes: is it more likely than not that a particular element is inherent in the reference?

²⁹ It is not logically possible to hold otherwise. For example, suppose a particular claim had only three elements: (a), (b), and (c). Suppose (for anticipation purposes) any single element in the claim, *e.g.* element (b), had to be proven by a standard *higher than* a preponderance of the evidence. If this were true, the rule of law that anticipation need only be established by a preponderance of the evidence would be violated. This is because the standard for any legal test is only as low as the standard for the highest element. In other words, the highest standard of any one element must determine the lowest possible standard for the overall test.

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Reconciling with Continental Can

41. As noted above, the Examiner has shown above that inherency during ex parte examination need only be established by a preponderance of the evidence. Moreover, the Examiner previously noted that *Continental Can Co. v. Monsanto Co.* is often cited as *the* authority for the test on inherency. In particular, the following is frequently quoted:

Inherency, however may not be established by probabilities or possibilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient. *Continental Can*, 948 F.2d at 1269, 20 USPQ2d at 1749.

42. Other cases have employed similar statements that essentially restate this proposition from *Continental Can*.³⁰ However an important distinction becomes self-evident: *Continental Can* involves an interparty infringement suit where the presumption of validity under 35 U.S.C. §282 applies. It is *not* ex parte examination. If *Continental Can* proffers any rule regarding inherency, it must be kept in mind that such rule must include the presumption of validity. And as noted above, this is not our case.

³⁰ See e.g. *In re Rijckaert*, 9 F.3d 1531, 1534, 28 USPQ2d 1955, 1957 (Fed. Cir. 1993) quoting in part *In re Oelrich*, 666 F.2d 578, 581-82, 212 USPQ 323, 326 (CCPA 1981) (“The mere fact that a certain thing may result from a given set of circumstances is not sufficient to establish inherency.”); *Talbert Fuel Systems Patents Co. v. Unocal Corp.*, 275 F3d 1371, 61 USPQ2d 1363 (Fed. Cir. 2002) citing *Continental Can* (“The mere fact that a certain thing may result from a given set of circumstances is not sufficient.”).

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43. In fact, the court in *Schering* discussed *Continental Can* and noted that *Continental Can* stands for the proposition that inherency requires a determination of the meaning of the prior art through the eyes of one of ordinary skill in the art:

Read in context, *Continental Can* stands for the proposition that inherency, like anticipation itself, requires a determination of the meaning of the prior art. Thus, a court may consult artisans of ordinary skill to ascertain their understanding about subject matter disclosed by the prior art, including features inherent in the prior art. A court may resolve factual questions about the subject matter in the prior art by examining the reference through the eyes of a person of ordinary skill in the art, among other sources of evidence about the meaning of the prior art. *Schering*, 339 F.3d at 1377-78, 67 USPQ2d at 1667 (citations omitted).

44. In other words, the factual question of whether it is more likely than not that Streetprices 1/99 discloses the inherent features is viewed through the eyes of a person of ordinary skill in the art. In this case, one of ordinary skill in the art clearly recognizes that it is more likely than not that the claimed features are inherent in the computer programs implementing the Streetprices 1/99 Web sites because Streetprices 1/99 performs all the claimed functions.

45. Also because of *Schering*, it may now be debatable that the holding from *Continental Can* establishes “the test” for inherency. In any event, one point remains unmistakably clear, *Continental Can* did not set the *standard* by which the test is judged. Yet even assuming *Continental Can* remains the test, it begs the question: how does the Examiner’s position reconcile with the test as established *Continental Can*?

46. The two rules of law are reconciled by adopting the position that during ex parte examination, inherency can not be established by probabilities or possibilities *less than a*

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preponderance of the evidence. The mere fact that a certain thing may result from a given set of circumstances (again, by showing evidence *less than* a preponderance of the evidence) is not sufficient. What is sufficient is to show that it is more likely than not that a particular claim element is found in the prior art. In other words, its acceptable that during ex parte examination, inherency may be established with some uncertainties, with some probabilities or possibilities against inherency and still comply with *Continental Can*.

47. It must be kept in mind that anticipation can practically never be proven with 100% certainty. Likewise, inherency too can never be proven with 100% certainty. If an examiner had to prove anticipation with 100% certainty, virtually all patent applications would be allowed, the concept of prima facie case³¹ would have no meaning, and the patent system would suffer greatly. And since inherency is an element of anticipation (or even an element of an obviousness determination for that matter), its axiomatic that it too can never be proven with 100% certainty.

48. It is therefore a practical conclusion that to establish anticipation or inherency, one need only establish such facts with a certainty somewhere between 50-100%. Specifically and as noted above, inherency during an infringement suit need only be proven by clear and convincing evidence while inherency during ex parte examination need only be proven by a preponderance of the evidence.

49. However even the 'clear and convincing' standard seems to, on its face, violate *Continental Can*'s prohibition against establishing inherencies by "probabilities or possibilities"

³¹ See *Oetiker*, 977 F.2d at 1445, 24 USPQ2d at 1444.

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because it must include at least *some* probabilities or possibilities. Black's Law Dictionary³² defines "clear and convincing proof" as:

That proof which results in reasonable certainty of the truth of the ultimate fact in controversy. Proof which requires more than a preponderance of the evidence but less than proof beyond a reasonable doubt. Clear and convincing proof will be shown where the truth of the facts asserted is highly probable.

50. It is axiomatic then that the rule from *Continental Can* must encapsulate establishing inherency by at least *some* probabilities or possibilities. 'Highly probably' is not 100% certainty. Because the rule from *Continental Can* therefore must include *some* probabilities or possibilities, the Examiner's position that inherency during ex parte examination may nevertheless be established with *some* probabilities or possibilities must also be equally valid.

Consistent with the Administrative Procedure Act & USPTO Policy

51. On a procedural matter, the Examiner notes that because the USPTO must follow the APA³³, the standard for review of USPTO factual determinations *on appeal* to the Federal Circuit is now "substantial evidence"³⁴ and not the 'clearly erroneous' standard as set forth in *Caveney*.

³² Black's Law Dictionary, Abridged 6th Ed., West Publishing Co., 1991.

³³ See *In re Lee*, 277 F.3d 1338, 1342, 61 USPQ2d 1430, 1432 (Fed. Cir. 2002)("Tribunals of the PTO are governed by the Administrative Procedure Act") citing *Dickinson v. Zurko*, 527 U.S. 150, 50 USPQ2d 1930 (1999).

³⁴ *In re Gartside*, 203 F.3d 1305, 1316, 53 USPQ2d 1769, 1776 (Fed. Cir. 2000).

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However, because the standard the USPTO must meet to *establish* a prima facie case remains unchanged by *Gartside*, *Caveney* remains controlling on this point.

52. Finally, the Examiner's position is also consistent with USPTO policy. See MPEP §706 which states in part: "The standard to be applied in *all cases* is the 'preponderance of the evidence' test. In other words, an examiner should reject a claim if, in view of the prior art and evidence of record, it is more likely than not that the claim is unpatentable. [Emphasis added.]"

Anticipation

53. "The dispositive question regarding anticipation is whether one skilled in the art would reasonably understand or infer from the prior art reference's teaching that every claim limitation was disclosed in that single reference." *Akamai Technologies Inc. v. Cable & Wireless Internet Services Inc.*, 68 USPQ2d 1186, 1190 (Fed. Cir. 2003)(citations and quotations omitted). Based upon the discussion above regarding inherency and the operation of Streetprices 1/99, the Examiner finds that one of ordinary skill in the art would reasonably infer it is more likely than not that all limitations in claim 15 (including all structural and functional limitations) are disclosed either directly or inherently in Streetprices 1/99.

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Obviousness

54. Applicants next argues something regarding the “instructions for parsing” phrase and argue that the “Office Action simply fails to address this limitation.”³⁵ Seeing as the “instruction for parsing” phrase was only recently added to claim 15 in Applicants’ *latest* amendment, it true that the *previous* Office Action never did address the “instructions for parsing” phrase. However all claim limitations were nevertheless considered.³⁶ And after further review of Applicants latest amendment, all claim limitations have again been considered.

55. While it is agreed that the Examiner bears the initial burden of establishing the prima facie case, the Examiner finds that this has been established. To support a prima facie case of obviousness for claims 1-14, the Examiner relies on the rejections of claim 15 and Applicant’s admission that claims 1-14 are not patentably distinct from claim 15.

Lexicography

56. Finally, Applicants quote the entire paragraph 17 from the previous Office Action and state that “this right may be invoked at anytime during the prosecution of the application. The examiner has no authority to impose a time limit on this right.”³⁷ First and foremost, a careful review of the quoted paragraph will reveal that the only requirement expressly stated by the

³⁵ Applicants’ “Remarks,” Paper No. 10, Page 10, ~ line 1.

³⁶ See the Previous Office Action, Paper No. 9, Paragraph No. 19.

³⁷ *Id.* at Page 12, ~ line 13.

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Examiner was that Applicants' response must comply with 37 C.F.R. §1.111(b). However the practical effect of 37 C.F.R. §1.111(b), the fact that claim terms are fixed upon filing, Applicants' duty of candor and good faith as noted in 37 C.F.R. §1.56, and the Examiner's reliance on the lack of a lexicographic definition, requires Applicant to point out a lexicographic definition in the claims if it is known to them.

57. First, the Examiner has never *required* Applicants to be their own lexicographer. It is Applicants' burden to define their invention, not the Examiner's.³⁸ In complying this burden, Applicants are reminded that it is Applicants—and *not* the Examiner—who drafted the claims, specification, and drawings and it is therefore *Applicants* who must decide whether or not to be their own lexicographer.³⁹ Along the same line of reasoning, whether or not Applicants choose this or that particular method of claim construction (*e.g.* lexicography or perhaps 35 U.S.C. §112 6th paragraph) is also completely within Applicants' discretion.

58. With this in mind, one point is especially clear, once Applicants' patent application is filed, meanings of *all* claim terms become fixed.⁴⁰ The Examiner recognizes that the revealing of term

³⁸ *Morris*, 127 F.3d at 1056, 44 USPQ2d at 1029 (quoting 35 U.S.C. §112 2nd paragraph, "It is the applicants' burden to precisely define the invention, not the PTO's.").

³⁹ See *e.g. Lear Siegler, Inc. v. Aeroquip Corp.*, 733 F.2d 881, 221 USPQ 1025, 1031 (Fed. Cir. 1984) (noting that "It is the inventor applying for a patent who is permitted to be his own lexicographer," not the examiner).

⁴⁰ See *Middleton Inc. v. Minnesota Mining and Manufacturing Co.*, 311 F.3d 1384, 1389, 65 USPQ2d 1138, 1142 (Fed. Cir. 2002) ("The meaning of a patent term, however, is not subject to revision The meaning of patent terms depends on the usage of those terms in context by one of skill in the art *at the time of application*. [Emphasis added.]"); *Wiener v. NEC Elecs., Inc.*,

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meanings may occur in either ex parte examination⁴¹ proceedings or in interparty litigation⁴² and includes revealing of lexicographic and non-lexicographic terms, both express and latent definitions⁴³ (*i.e.* during examination), and express and implicit definitions (*i.e.* after issuance).

102 F.3d 534, 539, 41 USPQ2d 1023, 1027 (Fed. Cir. 1996) (“Ultimately, a court must construe the claim language according to the standard of what those words would have meant to one skilled in the art *as of the application date*. [Emphasis added.]”)(overruled on other grounds in *Cybor Corp. v. FAS Techs., Inc.*, 138 F.3d 1448, 1454-55, 46 USPQ2d 1169, 1173 (Fed. Cir. 1998) (en banc)); and *Plant Genetic Systems N.V. v. DeKalb Genetics Corp.*, 315 F.3d 1335, 1345, 65 USPQ2d 1452, 1460 (Fed. Cir. 2003)(“We hold that the district court did not ignore the plain meaning of the claims, but properly gave objective meaning to them as they were understood *at the time the patent application was filed*. [Emphasis added.]”).

⁴¹ See *e.g. Bass*, 314 F.3d at 577-78, 65 USPQ2d at 1158 (noting that “Bass chose to define ‘motorized sports boat’ in the specification. He cannot change or modify that definition on appeal.”).

⁴² See *e.g. Jack Gluttman, Inc. v. Kopykake Enterprises, Inc.*, 302 F.3d 1352, 1360, 64 USPQ2d 1302, 1307 (Fed. Cir. 2002) (“Where, as here, the patentee has clearly defined a claim term, that definition usually is dispositive; it is the single best guide to the meaning of a disputed term.”).

⁴³ A ‘latent lexicographic definition’ is a new term introduced by the Examiner. A latent lexicographic definition is a lexicographic definition that is ‘discovered,’ ‘brought to light,’ or ‘uncovered’ by Applicants during examination and where support for the definition’s meaning is found in the originally filed disclosure. These definitions can not actually *change* term meaning because they are based upon the originally filed specification and were, in essence, present upon filing. Terms or definitions that actually *change* claim meaning by their inclusion *after* filing the filing date of the application are improper under either 35 U.S.C. §112 1st paragraph and/or 35 U.S.C. §132 since it is axiomatic that any *change* from an initial meaning would clearly constitute new matter. A latent definition lexicographic definition not transformed into express lexicographic definition during examination automatically becomes an implicit lexicographic definition, as described in *Bell Atlantic Network Services Inc. v. Covad Communications Group Inc.*, 262 F.3d 1258, 1271, 59 USPQ2d 1865, 1872-1873 Fed. Cir. 2001), upon issuance resulting in all lexicographic definitions (if any) being either *express* and *implicit* lexicographic definitions in the issued patent.

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59. Furthermore, an essential purpose of examination is to fashion claims that are precise, clear, and unambiguous thus removing uncertainties (including lexicographic uncertainties) as much as possible.⁴⁴ This, along with the notice function⁴⁵ of the claims, promotes Applicants' disclosure of any lexicographic definition known to them.

60. Again, it is important to remember that even though a definition may be transformed from a latent definition into an express definition during examination, the definition itself is fixed and therefore never changes. However even if the meaning of a claim term is not brought to light until the claim term is construed during a subsequent infringement suit, the fixation of term meaning is nevertheless present.⁴⁶ And even then, courts can not change the meaning of claim

⁴⁴ *In re Zletz*, 893 F.2d 319, 322, 13 USPQ2d 1320, 1322 (Fed. Cir. 1989) ("An essential purpose of patent examination is to fashion claims that are precise, clear, correct, and unambiguous. Only in this way can uncertainties of claim scope be removed, as much as possible, during the administrative process.").

⁴⁵ See *Johnson & Johnston Associates*, 285 F.3d at 1052, 62 USPQ2d at 1228 ("The claims thus give notice of the scope of patent protection. The claims give notice both to the examiner at the U.S. Patent and Trademark Office during prosecution, and to the public at large, including potential competitors, after the patent has issued.").

⁴⁶ See *e.g. Vitronics Corp. v. Conceptronic, Inc.*, 90 F.3d 1576, 1582, 39 USPQ2d 1573, 1576 (Fed. Cir. 1996) (where lexicographic definitions were not construed until a patent infringement suit).

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terms.⁴⁷ So failure to construe a claim term at any stage (*i.e.* either examination or litigation) in no way means that the meanings of claim terms are *not* fixed.

61. The Examiner recognizes that drafting patent applications is a complicated process requiring the drafter to consider many complex issues.⁴⁸ However this does not relieve the drafter of deciding whether or not to be their own lexicographer and if affirmative, unequivocally stating those definitions in the specification. Such definitions and associated issues must be contemplated *prior to* filing the patent application. Whether its during examination or infringement litigation, had a particular lexicographic definition “actually been contemplated *during preparation* of the . . . patent application, that teaching could have been unequivocally stated [Emphasis added.]” *Lear*, 221 USPQ at 1031-32 (citations omitted). And as noted above, it is objectively evident that Applicants had *not* contemplated any lexicographic definitions *during preparation* of their patent application. Lexicographic claim terms—like all claim terms—are fixed upon filing. Logic dictates that the converse must be equally true; that is, the *absence* of lexicographic terms is also fixed upon filing.

⁴⁷ See *Resonate Inc. v. Alteon Websystems, Inc.*, 338 F.3d 1360, 1365, 67 USPQ2d 1771, 1775 (Fed. Cir. 2003)(“Courts do not rewrite claims; instead, we give effect to the terms chosen by the patentee. Courts can neither broaden nor narrow the claims to give the patentee something different than what he has set forth.”).

⁴⁸ See *e.g. Johnson & Johnston Associates*, 285 F.3d at 1069, 62 USPQ2d at 1241, Newman, J., dissenting (“Patentees often must draw lines in order to claim their invention with specificity.”).

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62. In conclusion, the Examiner has in essence merely reminded Applicants to comply with all applicable statutes, rules, and requirements. When not required to by law, emphasizing or calling attention to a particular statute, rule, or requirement by reciting it in an office action is really only *reminding* Applicants to comply the requirement or providing “actual notice” to Applicants of the requirement. This reminding or providing of “actual notice” primarily occurs when the statute, rule, or requirement is, in the experience of the USPTO, problematic. So while compliance with *all* applicable statutes, rules, or requirements is always required, calling attention to a particular statute, rule, or requirement usually means that the particular statute, rule, or requirement may pose problems to applicants and applicants should thoroughly consider the consequences associated with the statute, rule, or requirement before proceeding any further.

63. So like always, the Examiner has not made any *additional* requirements. Again, to be perfectly clear, the Examiner has simply reminded Applicants that their lexicography response at this time⁴⁹ must (like always) comply with 37 C.F.R. §1.111(b) and their duties of candor and good faith as described in 37 C.F.R. §1.56. In any event, one point remains unmistakably clear, such comments by Applicants confirm that Applicants have received actual notice of the

⁴⁹ Obviously, should Applicants actually make an attempt at lexicography, additional requirements would then become necessary. These include but are not limited to compliance with 35 U.S.C. 112 2nd paragraph; the “reasonable clarity, deliberateness, and precision” of the lexicography as noted in *Renishaw PLC v. Marposs Societa' per Azioni*, 158 F.3d 1243, 1249, 48 USPQ2d 1117, 1121 (Fed. Cir. 1998); and other requirements such as those noted in *Johnson Worldwide Assocs.*, *supra*. However, without such invocation, compliance with these additional requirements is obviously not necessary at this time.

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Examiner's factual findings and legal conclusions regarding lexicography and have been given an opportunity to defend against the corresponding noticed liabilities.

Conclusion

64. **THIS ACTION IS MADE FINAL.** Applicants are reminded of the extension of time policy as set forth in 37 C.F.R. §1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 C.F.R. §1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

65. The following two (2) citations to the Manual of Patent Examining Procedure ("MPEP") apply to this Office Action: MPEP citations to Chapters 200, 700, 1800, and 2100 are from the MPEP 8th Edition, Rev 1, February 2003. All remaining MPEP citations are from MPEP 8th Edition, August 2001.

66. Because this application is now final, Applicants are reminded of the USPTO's after final practice as discussed in MPEP §714.12 and §714.13 and that entry of amendments after final is

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not a matter of right. “The refusal of an examiner to enter an amendment after final rejection of claims is a matter of discretion.” *In re Berger*, 279 F.3d 975, 984, 61 USPQ2d 1523, 1529 (Fed. Cir. 2002) (citations omitted). Furthermore, suggestions or examples of claim language provided by the Examiner are just that—suggestions or examples—and do not constitute a formal requirement mandated by the Examiner. Unless stated otherwise by an express indication that a claim is “allowed,” exemplary claim language provided by the Examiner to overcome a particular rejection or to change claim interpretation has *not been addressed* with respect to other aspects of patentability (*e.g.* §101 patentable subject matter, §112 1st paragraph written description and enablement, §112 2nd paragraph indefiniteness, and §102 and §103 prior art). Therefore, any claim amendment submitted under 37 C.F.R. §1.116 that incorporates an Examiner suggestion or example or simply changes claim interpretation will nevertheless require further consideration and/or search and a patentability determination as noted above.

67. In accordance with *In re Lee*, 277 F.3d 1338, 1344-45, 61 USPQ2d 1430, 1434-35 (Fed. Cir. 2002), the Examiner again finds that the references How Computers Work Millennium Ed. by Ron White; How Networks Work, Millennium Ed. by Frank J. Derfler et. al.; and How the Internet Works, Millennium Ed. by Preston Gralla are additional evidence of what is basic knowledge or common sense to one of ordinary skill in this art. Each reference is cited in its entirety. Moreover, because these three references are directed towards beginners (see *e.g.* “User Level Beginning . . .”), because of the references’ basic content (which is self-evident upon review of the references), and after further review of both the intrinsic evidence of record and the entire

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art now of record in conjunction with the factors as discussed in MPEP §2141.03 (where practical), the Examiner finds that these three references are primarily directed towards those of low skill in this art. Because these three references are directed towards those of low skill in this art, the Examiner finds that one of ordinary skill in this art must—at the very least—be aware of the knowledge and information contained within these three references.

68. It is the Examiner's factual determination that all limitations in claim 15 has been considered and are either disclosed or inherent in the reference(s) as discussed above.

Furthermore, the inherent features are established by a preponderance of the evidence. *In re Epstein*, 32 F.3d 1559, 1564, 31 USPQ2d 1817, 1820 (Fed. Cir. 1994) ("Preponderance of the evidence is the standard that must be met by the PTO in making rejections." (citations and quotations omitted)).

69. All factual findings and conclusions of law in this Office Action are based the entire record. Although the Examiner may have singled out various items of evidence (*e.g.* Streetprices 1/99) and expressly noted its content, the other documents of record were also considered and applied when making the Examiner's factual findings and conclusions of law. Moreover, because many of the canons of claim construction are generally viewed from a person of ordinary skill in the art,⁵⁰ the other documents of record not specifically mentioned in the prior art rejections above

⁵⁰ See *e.g. Orthokinetics, Inc. v. Safety Travel Chairs, Inc.*, 806 F.2d 1565, 1576, 1 USPQ2d 1081, 1088 (Fed. Cir. 1986)(noting that the definiteness inquiry focuses on whether those skilled in the art would understand the scope of the claim).

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were nevertheless used in the Examiner's deliberative process to assess, inter alia, the definiteness of the claims, the level of skill in the art, and ultimately the patentability of the claimed invention.

70. In accordance with the USPTO's goals of customer service, compact prosecution, and reduction of cycle time, the Examiner has made every effort to clarify his position regarding claim interpretation and any rejections or objections in this application. Furthermore, the Examiner has again provided Applicants with notice—for due process purposes—of his position regarding his factual determinations and legal conclusions. The Examiner notes and thanks Applicants for their "Remarks" (Paper No. 10 beginning on page 5) traversing the Examiner's positions on various points. If Applicants disagree with any additional factual determination or legal conclusion made by the Examiner in this Office Action whether expressly stated or implied⁵¹, the Examiner respectfully reminds Applicants to properly traverse the Examiner's position(s) in accordance with 37 C.F.R. §1.111(b) *in their next properly filed response*. By addressing these issues now, matters where the Examiner and Applicants agree can be eliminated allowing the Examiner and Applicants to focus on areas of disagreement (if any) with the goal towards allowance in the shortest possible time. If Applicants have *any* questions regarding the Examiner's positions or have other questions regarding this communication or even previous communications, Applicants are strongly encouraged to contact Examiner Andrew J. Fischer whose telephone number is (703) 305-0292. If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's

⁵¹ *E.g.*, if the Examiner rejected a claim under §103 with two references, although not directly stated, it is the Examiner's implied position that the references are analogous art.

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immediate supervisor, Robert Olszewski, can be reached at (703) 308-5183. The fax number for facsimile responses is now (703) 872-9306.

AJFischer 11/5/03

Andrew J. Fischer
Patent Examiner

AJF
November 5, 2003